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09/921,856	08/02/2001	Gregory P. Fitzpatrick	BOC9-2000-0082(217)	7129

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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT

PAPER NUMBER

2175

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/921,856

Applicant(s)

FITZPATRICK ET AL.

Examiner

Neveen Abel-Jalil

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**SAM RIMELL**  
PRIMARY EXAMINER

**DETAILED ACTION**

***Response to Amendment***

1. The declaration filed on 22-July-2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the Whitten, II (U.S. Pub. No. 2002/0083136 A1) and McDowell et al. (U.S. Pub. No. 2002/0035605 A1) references.
2. The evidence submitted in the disclosure document does not illustrate diligence from the date of conception to the filing of the present application which spans nine months.
3. The Examiner respectfully points out the date of the document creation under the heading "Created on:" on page 12, line 3, does not make sense in view of the "Submitted Date" on page 12, line 14. The information suggests that the disclosure document has two conception dates: 11/10/200 and 11/17/2000. The evidence of conception must be clear and unambiguous.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell et al. (U.S. Pub. 2002/0035605) in view of Whitten, II (U.S. Pub. 2002/0083136).

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As to claims 1, and 12, McDowell et al. discloses a method for generating a list of contacts, a machine readable storage having stored thereon a computer program for generating a list of contacts, said machine readable storage having a plurality of code sections executable by a machine for causing the machine to perform a series of steps (See page 8, column 1, lines 13-21, also see page 15, column 1, lines 1-28) comprising the steps of:

first retrieving a plurality of contacts from an exposed, remotely accessible contact list (See page 13, column 1, lines 30-42, wherein “retrieving” reads on “importing”, and wherein “remotely accessible” reads on “WAP Interface”),

first comparing said first retrieved contacts to stored contacts in a locally accessible contact list (See page 13, column 1, lines 1-13, wherein “comparator” reads on “synchronize”);

second retrieving a plurality of contacts from an exposed, remotely accessible contact list associated with one of said first retrieved contacts; second comparing said second retrieved contacts to said locally stored contacts (See page 10, column 1, lines 1-34, wherein “comparing” reads on “update”, and wherein “remotely accessible” reads on “wireless subscriber”).

McDowell et al. does not disclose first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts; and,

storing said identified common contacts in a list of common contacts.

Whiten, II discloses first identifying common contacts among said first compared contacts (See page 1, column 2, lines 1-14);

second identifying common contacts among said second compared contacts (See page 1, column 2, lines 1-14); and,

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storing said identified common contacts in a list of common contacts (See page 2, column 2, lines 24-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McDowell et al. to include first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts; and, storing said identified common contacts in a list of common contacts.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McDowell et al. by the teaching of Whiten, II to include first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts; and, storing said identified common contacts in a list of common contacts because it provides for efficient database organization and access thereby reducing processing time and business expenses.

As to claims 2, and 13, McDowell et al. as modified discloses further comprising the step of repeating said second retrieving, second comparing and second identifying steps for each first retrieved contact not identified as a common contact in said first identifying step (See Whitten, III page 2, column 1, lines 26-51, wherein “not identified” reads on “restriction...authorized only”).

As to claims 3, and 14, McDowell et al. as modified discloses wherein said second retrieving step comprises the step of second retrieving a plurality of contacts from an exposed,

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remotely accessible contact list associated with one of said first retrieved contacts not identified as a common contact in said first identifying step (See Whitten, III page 2, column 1, lines 1-24, wherein “exposed” reads on “status indicator”, and wherein “not identified as common contact” reads on “potential list”).

As to claims 4, and 15, McDowell et al. discloses a method generating a list of common contacts, a machine readable storage having stored thereon a computer program for generating a list of common contacts, said machine readable storage having a plurality of code sections executable by a machine for causing the machine to perform a series of steps (See page 8, column 1, lines 13-21, also see page 15, column 1, lines 1-28), said steps comprising:

exchanging contact lists over a physical communications link (See page 13, column 1, lines 30-42, wherein “exchanging” reads on “importing”, and wherein “physical communications link” reads on “WAP Interface”);

McDowell et al. does not disclose comparing contacts in said exchanged contact lists to identify matching contacts; and,

storing said matched contacts in a common contact list.

Whitten, III discloses comparing contacts in said exchanged contact lists to identify matching contacts (See page 2, column 1, lines 26-51, wherein “comparing” reads on “status indicator”, and wherein “matching contacts” reads on “potential contact”); and,

storing said matched contacts in a common contact list (See page 1, column 2, lines 1-32).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McDowell et al. to include comparing contacts in said exchanged contact lists to identify matching contacts; and, storing said matched contacts in a common contact list.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McDowell et al. by the teaching of Whiten, II to include comparing contacts in said exchanged contact lists to identify matching contacts; and, storing said matched contacts in a common contact list because it provides for efficient database organization and access thereby reducing processing time and business expenses.

As to claims 5, and 16, McDowell et al. discloses wherein said exchanging step comprises the steps of: establishing a wireless communications link; and, exchanging said contact lists over said established wireless communications link (See Whitten, III page 2, column 2, lines 1-33)

As to claims 6, and 17, McDowell et al. discloses a method of generating a list of common contacts, A machine readable storage having stored thereon a computer program for generating a list of common contacts, said machine readable storage having a plurality of code sections executable by a machine for causing the machine to perform a series of steps (See page 8, column 1, lines 13-21, also see page 15, column 1, lines 1-28), said steps comprising:

accessing a contact list (See page 8, column 2, lines 61-67, wherein "contact list" reads on "buddy list") in a remotely accessible database of contacts (See page 7, column 1, lines 46-60);

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providing a visual hyperlink for each matching contact produced by said comparing step (See page 7, column 1, lines 24-43, wherein “visual” reads on “Web”, and wherein “hyperlink” read son “URL”).

McDowell et al. does not disclose comparing contacts in said contact list with contacts in a stored database of contacts, said comparison producing matching contacts.

Whitten, III discloses comparing contacts in said contact list with contacts in a stored database of contacts, said comparison producing matching contacts (See page 2, column 1, lines 26-51, wherein “comparing” reads on “status indicator”, and wherein “matching contacts” reads on “potential contact”).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McDowell et al. to include comparing contacts in said contact list with contacts in a stored database of contacts, said comparison producing matching contacts.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McDowell et al. by the teaching of Whitten, II to include comparing contacts in said contact list with contacts in a stored database of contacts, said comparison producing matching contacts because it provides for efficient database organization and access thereby reducing processing time and business expenses.

As to claim 7, McDowell et al. discloses a common contact identification system (See page 8, column 2, lines 61-67) comprising:



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at least two contact lists, each said contact list comprising a plurality of contacts, each said contact list having a publicly accessible interface through which said contacts can be accessed remotely (See page 16, column 1, lines 1-32, wherein “contact lists” reads on “buddy lists”, and wherein “publicly accessible” reads on “Internet”, and wherein “accessed remotely” reads on “IM-Anywhere™”);

a comparator (See page 13, column 1, lines 1-13, wherein “comparator” reads on “synchronize”) for comparing contacts in each of said at least two contact lists, said comparator identifying matching contacts in each of said at least two contact lists (See page 10, column 1, lines 1-34, wherein “identifying matching” reads on “update”).

McDowell et al. does not disclose a common contact list comprising contacts matched by said comparator.

Whitten, III discloses a common contact list comprising contacts matched by said comparator (See page 1, column 2, lines 1-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McDowell et al. to include a common contact list comprising contacts matched by said comparator.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McDowell et al. by the teaching of Whitten, II to include a common contact list comprising contacts matched by said comparator because it provides for efficient database organization and access thereby reducing processing time and business expenses.

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As to claim 8, McDowell et al. as modified discloses wherein each said contact list is stored in a storage medium selected from the group consisting of a database (See page 7, column 1, lines 52-60), a contact management program data store, an e-mail program address book; an instant messenger address book (See page 7, column 2, lines 38-67), a cellular phone address book (See page 7, column 2, lines 1-7, wherein "cellular phone" reads on "mobile") and a personal digital assistant address book (See page 1, column 2, lines 1-7).

As to claim 9, McDowell et al. as modified discloses further comprising a communications link between said contact lists over which said contacts in said contact lists can be transmitted (See page 8, column 2, lines 23-31, wherein "communication link" reads on "Internet", also see page 1, column 1, lines 60-67).

As to claim 10, McDowell et al. as modified discloses wherein said communications link is selected from the group consisting of an infrared communications link, a short range radio frequency communications link, and a TCP/IP wireline link (See page 7, column 1, lines 8-14).

As to claim 11, McDowell et al. as modified discloses wherein said common contact list comprises at least one hyperlinked address of a matched contact (See page 7, column 1, lines 32-43, wherein "hyperlink" reads on "URL", also see page 13, column 2, lines 1-10).

### ***Conclusion***

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6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 703-305-8114. The examiner can normally be reached on 8:00AM-4: 30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 703-305-3830. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Neveen Abel-Jalil

  
**SAM RIMELL**  
**PRIMARY EXAMINER**